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Serial No. 09/783,961
Amendment dated October 4, 2006Attorney Docket No. 249/243
Response to Office action of April 4, 2006REMARKS

Prior to entry of the instant amendment, claims 1-14 are currently pending in the subject application, of which claims 8-12 and 14 are withdrawn. By the instant amendment, claims 7 and 11 are amended, and claims 1-6, as well as withdrawn claims 8-10 and 12, are cancelled. Claims 15-18 are added. Claim 7 is the sole independent claim.

Applicant appreciates the Examiner's acknowledgement of receipt of certified copies of the priority documents.

Applicant requests, in the next Office action, that the Examiner indicate the acceptability of the drawings filed on February 16, 2001.

Claims 1, 13 and 15-18 are presented to the Examiner for further or initial prosecution on the merits.

A. Introduction

In the outstanding Office action, the Examiner rejected claims 1-7 and 13 under 35 U.S.C. § 112, second paragraph; rejected claims 1-6 under 35 U.S.C. § 101 as directed to non-statutory subject matter; rejected claims 1 and 7 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,963,843 to Takatsu ("the Takatsu reference"); and rejected claims 2-6 and 13 under 35 U.S.C. § 103(a) over the Takatsu reference.

B. Asserted Rejection under 35 U.S.C. § 112, Second Paragraph

In the outstanding Office action, the Examiner rejected claims 1-7 and 13 under 35 U.S.C. § 112, second paragraph. In particular, the Examiner asserted,

Regarding claims 1 and 7, the word "means" is preceded by the word(s) "cyber payment" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

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(*Office action of April 13, 2006, at paragraph no. 6, page 2*)

By the instant amendment, claims 1-6 have been cancelled. Claim 7 has been amended to recite, *inter alia*, --a cyber payment means for paying in cyber space--. Applicant respectfully submits that claim 7, as well as the claims depending therefrom, is not indefinite. Accordingly, applicant respectfully requests that this rejection be reconsidered and withdrawn.

C. Asserted Rejection under 35 U.S.C. § 101

In the outstanding Office action, the Examiner rejected claims 1-6 under 35 U.S.C. § 101 as directed to non-statutory subject matter. By the instant amendment, claims 1-6 are cancelled. Accordingly, applicant respectfully submits that this rejection is moot and respectfully requests that it be reconsidered and withdrawn.

D. Asserted Rejection under 35 U.S.C. § 102(e)

In the outstanding Office action, the Examiner rejected claims 1 and 7 under 35 U.S.C. § 102(e) over the Takatsu reference. By the instant amendment, claim 1 is cancelled and, accordingly, the rejection thereof is moot. Regarding independent claim 7, applicant respectfully traverses this rejection, and respectfully submits that the Examiner failed to set forth a *prima facie* case of anticipation for at least the reasons set forth below.

As an initial matter, applicant notes that claim 7 recites a "cyber payment means." In the outstanding Office action, the Examiner failed to particularly identify a corresponding element in the Takatsu reference. It appears that the Examiner believes that the "electronic note" described in the Takatsu reference corresponds to the cyber payment means recited in claim 7, and therefore the following remarks will assume, *arguendo*, that this is the case.

Claim 7 recites, *inter alia*,

a server computer . . .; and
a database managed by the server computer;

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wherein the server computer . . .
at the request of a user accessing the server computer, issues the cyber payment means. . . and stores the issued cyber payment means by user in the database; and
if a first user . . . performs payment to a second user . . . the cyber payment means being moved from the first user to the second user inside of the database.

Applicant respectfully submits that the Takatsu reference fails to disclose, or even suggest, each and every element of claim 7. For example, the Takatsu reference fails to disclose the cyber payment means being moved from the first user to the second user inside of the database. The Takatsu reference does not move the electronic note from the first user to the second user, but rather deletes electronic notes and generates new electronic notes in their stead. For example, the Takatsu reference discloses,

Upon reception of those information and the separation requesting signal, the computer 11 commences the electronic note separation program 57 shown in FIG. 7.

After starting the electronic note separation program 57, the computer 11 searches the electronic note list 74 for the record that including the received authentication code 73, and deletes this record from the list 74 (S501).

Next, the computer 11 generates information which specifies a new electronic note whose amount is equal to the amount difference indicated by the information received from the computer 21 (S502). Then, the computer 11 combines this information and the information on the difference received from the computer 21 and encodes the resultant information, both by the same schemes as are used in step S112 by the electronic note generation program 52, thus generating an authentication code 73 (S503),

Then, the computer 11 generates a new record in the electronic note list 74 and stores information specifying the electronic note and information on the difference, received from the computer 21, in that record (S504).

(*The Takatsu reference, col. 17, lines 14-34 (emphasis added)).*

In view of the above, applicant respectfully submits that the Takatsu reference fails to disclose, or even suggest, each and every element of claim 7. Accordingly, claim 7, as well as the claims depending therefrom, is believed to be allowable over the Takatsu

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reference. Therefore, applicant respectfully requests that this rejection be reconsidered and withdrawn.

E. Asserted Rejection under 35 U.S.C. § 103(a)

In the outstanding Office action, the Examiner rejected claims 2-6 and 13 under 35 U.S.C. § 103(a) over the Takatsu reference. Applicant respectfully traverses this rejection, and respectfully submits that the Examiner failed to set forth a *prima facie* case of obviousness for at least the reasons set forth below.

Claim 13 and new claims 15-18 depend from claim 7, and are believed to be allowable for at least the reasons that claim 7 is allowable. Additionally, applicant notes that new claims 15-18 recite subject matter similar to that recited in canceled claims 3-6. Accordingly, to the extent that the remarks below are relevant to claims 2-6, they are considered to be similarly relevant to new claims 15-18.

1. In the approach taught by the Takatsu reference, a medium storing an exchange value unit identification code is produced and circulated off-line

In the Takatsu reference, in a request to generate electronic money, a user sends an exchange value unit identification code to an electronic note generation site. The exchange value unit identification code is stored on a medium, e.g., scratch paper, a floppy disk, a CD-ROM or another non-volatile recording medium. *See the Takatsu reference at, e.g., column 19, lines 14-19; column 21, lines 53-58.* Therefore, as described in the Takatsu reference, the medium that stores the exchange value unit identification code 71 is manufactured and circulated, which incurs large manufacturing costs while also exposing the operation to the risk of counterfeiting of the medium. Thus, the Takatsu reference suffers from the same problems that applicant has identified in the related art. *See the subject application at page 2, lines 2 and 4-7.*

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In contrast, the claims in the subject application are directed to a system wherein there is no need to manufacture and circulate a medium, since the cyber payment means is issued by the request of a user who has registered his/her account number and business identification information on a server computer. That is, the user does not need to input the exchange value unit identification code produced and circulated by the electronic note generation site, etc. Therefore, in the claimed system, the manufacturing costs and risks of counterfeiting associated with the approach taught by the Takatsu reference need not be incurred.

2. The approach taught by the Takatsu reference maintains anonymity

One of objectives of the approach taught by the Takatsu reference is to maintain the anonymity of the generation of an electronic note and previous participants who were involved with the electronic note. *See the Takatsu reference at, e.g., column 6, lines 55-62.* In contrast, the claims in the subject application are directed to a system that may prevent anonymity. In particular, the user who requested the generation of the cyber payment means may be required to register his current account number and business identification information, after which the cyber payment means can be marked with a business identifier of the corresponding user. Therefore, this objective of the Takatsu differs from that of the subject application.

3. The approach taught by the Takatsu reference requires a user to install separate software on the user's computer

In the approach taught by the Takatsu reference, a user site performs a large variety of functions, such as sending the exchange value unit identification code stored in scratch paper, a floppy disk, a CD-ROM or another non-volatile recording medium to the electronic note generation site, receiving and storing an authentication code from the electronic note generation site, sending the authentication code to a transaction site, etc. Therefore, several

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programs, such as an electronic note request program 54, a transaction request program 55 and a decoding program 56c, should be installed in the user site.

In contrast, the claims in the subject application are directed to a system which does not require the user to install separate software on the user's computer, since the processes like generating the cyber payment means and moving the cyber payment means from the first user to the second user are only performed in the database.

In view of the above, applicant respectfully submits that claims 13 and 15-18 are allowable over the Takatsu reference. Accordingly, applicant respectfully requests that this rejection be reconsidered and withdrawn.

F. Rejoinder Requested

Applicant respectfully submits that claim 7, which is generic to all of the remaining claims in the application, is allowable over the cited prior art. Accordingly, applicant respectfully requests that withdrawn claims 11 and 14 be rejoined, and a notice of allowance be provided. Applicant notes that claim 11 is amended by the instant amendment in order to correct minor typographical errors.

G. Conclusion

The remaining documents cited by the Examiner were not relied on to reject the claims. Therefore, no comments concerning these documents are considered necessary at this time.

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

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In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.

Respectfully submitted,

LEE & MORSE, P.C.

Date: October 4, 2006

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PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying papers may also be charged to Deposit Account No. 50-1645.

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